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10/608,525

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Giacomo Digrigoli

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05/01/2008

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EXAMINER

POINVIL, FRANTZY

ART UNIT

PAPER NUMBER

3692

NOTIFICATION DATE

DELIVERY MODE

05/01/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/608,525 | Applicant(s) DIGRIGOLI ET AL. | |
| | Examiner Frantzy Poinvil | Art Unit 3692 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments filed 1/14/2008 have been fully considered but they are not persuasive.

Arguments:

2. Applicant's representative states that the claim 1, 24, 34 and 36 require communicating to a sender information identifying a current exchange rate for conversion the sender-selected currency and a sender primary currency and argues that the prior art fails to teach or suggest this limitation. Applicant further argues that claims 13, 31, 35 and 37 require receiving a recipient decision with respect to an acceptance of the payment in the sender-selected currency and also argues that the prior art fails to teach or suggest this limitation.

In response, the Examiner respectfully disagrees with the applicant's assertion. It is noted that Boesch et al are directed to a method and system for "determining approval of a transaction between a merchant and a customer. The transaction includes the merchant providing a product to the customer at a price in a first merchant currency. The price in the first merchant currency is known by the customer. The system comprises a customer device associated with the customer. The customer device has a first set of data including a customer amount in a customer currency. The system also includes a server connected to the customer device having the merchant price in the first merchant currency for receiving the first set of data, and for approving the transaction when the customer amount in the customer currency is within a risk range of the price in the merchant currency in accordance with current exchange rates. determining approval of a transaction between a merchant and a customer. The transaction includes the merchant providing a product to the customer at a price in a first merchant currency. The price in the first

merchant currency is known by the customer. The system comprises a customer device associated with the customer. The customer device has a first set of data including a customer amount in a customer currency. The system also includes a server connected to the customer device having the merchant price in the first merchant currency for receiving the first set of data, and for approving the transaction when the customer amount in the customer currency is within a risk range of the price in the merchant currency in accordance with current exchange rates". See column 3, lines 3-17 of Boesch et al. Boesch et al further teach that a customer may hold a plurality of different accounts in a plurality of different currencies. See column 11, lines 7-23. The customer may convert one of their selected currency to a primary currency and then may send the converted currency to a merchant accepted currency. The applicant is directed to column 11, line 49 to column 12, line 6 of Boesch et al.

3. Thus applicant's arguments are not persuasive.

4. The prior Office action is repeated below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Boesch et al. (US Patent No. 5,897,621).

As per claims 1-37, Boesch et al disclose a system and method for processing payment transactions in a multi-currency payment system. The system and method comprise communicating to a sender via a communications network a user interface that facilitates sender input with respect to a desired currency in which a payment is to be made; receiving data identifying a sender-selected currency from the sender via the communications network; communicating to the sender via the communications network information identifying a current exchange rate for conversion between the sender-selected currency and a sender primary currency; and if receiving a confirmation of the payment in the sender-selected currency from the sender, informing a recipient via the communications network about the payment in the sender-selected currency. Boesch et al also disclose teach a sender funds analyzer and a recipient analyzer.

Applicant is directed to column 7, line 7 to column 9, line 25.

Boesch et al further disclose the sender primary currency is a currency used in a majority of transactions involving the sender and wherein the payment is to fund from a balance in the sender-selected currency that is maintained within a sender account. See column 5, lines 44-64 and column 6, lines 20-31 and lines 44-49 of Boesch et al.

Boesch et al also teach determining that the sender does not have a balance in the sender selected currency within the sender account and converting an equivalent value in the sender primary currency into the sender-selected currency to fund the payment. See column 6, lines 20-31, column 4, lines 8-45 and column 10, lines 29-65 of Boesch et al.

Boesch et al also disclose updating the current exchange rate at predefined time intervals and upon determining that a predefined time interval has expired, retrieving current exchange rates from a third party system, applying a set of rules to the retrieved rates to verify that the retrieved rates are correct and replacing existing rates are correct and replacing existing rates stored in a database with the retrieved rates. See column 8, line 49 to column 9, line 3.

Boesch et al also disclose accumulating payment transactions in each of a plurality of currencies used during the predefined time interval; requesting the third party system to trade the accumulated payment transactions and receiving confirmation from the third party system that trades of the accumulated payment transactions have been completed. See column 14, lines 14-40.

Functions of determining that the recipient did not accept the payment in the sender-selected currency and displaying an error message to the sender offering the sender to select a different currency for the payment are to provide an interactive session to the involved parties are inherent features in the system of Boesch et al.

The computerized system stores all transactions involved all clients that are stored for inventory control and dispute resolution purposes. Thus, a history of currency conversion calculations from previous transactions involving the sender is an inherent feature in the system of Boesch et al.

Boesch et al also disclose determining whether a recipient requests a conversion of the payment account into the recipient primary currency, and if not creating a new balance in the sender-selected currency within the recipient account and adding the payment amount to the new balance. See column 4, lines 8-45.

Boesch et al also teach that payments will be block for which the recipient does not have a balance.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3692

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Frantzy Poinvil/
Primary Examiner
Art Unit 3692**

FP
April 17, 2008